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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,993	11/30/2000	Guido M. Schuster	00-348	3463
20306	7590	05/20/2004	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			FOX, JAMAL A	
300 S. WACKER DRIVE			ART UNIT	
32ND FLOOR			PAPER NUMBER	
CHICAGO, IL 60606			2664	
DATE MAILED: 05/20/2004				

[Handwritten initials]

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,993

Applicant(s)

SCHUSTER ET AL.

Examiner

Jamal A Fox

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-5 and 10-19.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by anticipated by Schuster et al. (U.S. Patent No. 6,577,622).

The applied reference has a common ~~assignee~~ and ~~inventor~~ with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this

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application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Referring to Claim 1 Schuster et al. discloses, a system (Fig. 2) for communicating messages comprising:

a data network (Fig. 2, ref. sign 206 and respective portions of the spec.) to provide data connectivity for a plurality of data communications channels (Data Channel, Fig. 8B, ref. signs 486 and 488; and Fig. 9B ref. signs 518, 522 and 524 and respective portions of the spec.) using data transport protocols (Tiny TP, Fig. 5, ref. sign 610; and Figures 6 and 7, RTP and UDP and respective portions of the spec.);

first (Fig. 2, ref. sign 208 and respective portions of the spec.), second (Fig. 2, ref. sign 218 and respective portions of the spec.) and third (Fig. 2 ref. sign 228 and respective portions of the spec.) data network telephones connected to the data network, each of the first, second and third data network telephones operable to communicate a voice signal as voice-over-data packets on a voice-over-data channel (voice over data, col. 10 lines 32-36 and col. 12 lines 59-65), the voice over data channel being one of the plurality of data communications channels on the data network, each data network telephone operable to convert voice-over-data packets communicated on the voice-over-data channel to voice signals; and

a messaging application (SIP, Figures 6, 7, 8B, 9B and 10B) connected to the data network, the messaging application adapted to detect a first voice over data channel between the first data network telephone and the second data network telephone, to establish a messaging media connection comprising a second data

communications channel to the first data network telephone, to receive data messages from the third data network telephone and to send the data messages to the first data network telephone (the messaging application is stored in connection servers 250, 238, and 237 of Fig. 2 and respective portions of the spec.).

Referring to Claim 2 Schuster et al. discloses the system of Claim 1 wherein the messaging application is adaptable to detect a second voice over data channel (Fig. 8B, ref. sign 488; and Fig. 9B ref. sign 522 and respective portions of the spec.) to the third data network telephone and to send a contact user identifier (user identifier, col. 5 lines 57-67; and Fig. 11 ref. signs 928 and 932 and respective portions of the spec.) to the first data network telephone.

Referring to Claim 3 Schuster et al. discloses the system of Claim 1 wherein the messaging application is adapted to send a messaging input screen (Figures 11 and 12 and respective portions of the spec.) to the first data network telephone (Fig. 2, ref. sign 208 and respective portions of the spec.), the messaging input screen comprising a message input area (Email, Fig. 11) and a contacts available list (Fig. 11, Address Book).

Referring to Claim 4 Schuster et al. discloses the system of Claim 3 wherein the messaging application is adaptable to detect a second voice over data channel to the third data network telephone and to send a contact user identifier to the first data network telephone for display on the contacts available list (col. 20 lines 1-6).

Referring to Claim 5 Schuster et al. discloses the system of Claim 1 further comprising a contact list comprising at least one contact user identifier (user identifier,

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col. 5 lines 57-67; and Fig. 11 ref. signs 928 and 932 and respective portions of the spec.), wherein the messaging application is adapted to establish a data channel to each of the at least one contact user identifier (col. 19 line 59 – col. 20 line 15).

Referring to Claim 6 Schuster et al. discloses the system of Claim 5 wherein the messaging application is adapted to send a messaging report (“BYE message” and “OK messages”, col. 20 lines 5-15) to each of the at least one contact user identifiers (user identifier, col. 5 lines 57-67; and Fig. 11 ref. signs 928 and 932 and respective portions of the spec.).

Referring to Claim 7 Schuster et al. discloses the system of Claim 1 wherein the data messages comprise text-based messages (text, col. 14 lines 31-34, col. 16 lines 16-21 and col. 17 lines 57-61).

Referring to Claim 8 Schuster et al. discloses the system of Claim 1 wherein the data messages comprise voice-based messages (voice data, col. 17 lines 45-57).

Referring to Claim 9 Schuster et al. discloses a messaging application (SIP, Figures 6, 7, 8B, 9B and 10B) for communicating messages over a data network (Fig. 2, ref. sign 206 and respective portions of the spec.) comprising:

a connection detector (Fig. 2, Connection Server 250) adapted to detect a first voice over data channel (voice over data, col. 10 lines 32-36 and col. 12 lines 59-65) between a first telephone (Fig. 2, ref. sign 208) and a second telephone (Fig. 2, ref. sign 218);

a communications function (data communications channel, col. 8 lines 10-19) operable to establish a messaging media connection with the first telephone; and

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a messaging function (SIP INVITE, Fig. 8B and col. 19 line 27 – col. 20 line 15; and Fig. 9B and col. 21 line 19 – col. 22 line 13) operable to communicate a messaging input screen to the first telephone and to communicate data messages with the first telephone.

Referring to Claim 10 Schuster et al. discloses the messaging application of Claim 9 further comprising a contacts connected list comprising at least one contact user identifier (user identifier, col. 5 lines 57-67; and Fig. 11 ref. signs 928 and 932 and respective portions of the spec.).

Referring to Claim 11 Schuster et al. discloses the messaging application of Claim 10 further comprising a contacts detector (flag, col. 24 lines 8-36) to detect a data communications channel with the at least one of the contact user identifier.

Referring to Claim 14 Schuster et al. discloses the messaging application of Claim 11 comprising a contacts connected list (contact information, col. 24 lines 8-23) operable to store connected contacts detected by the contacts detector.

Referring to Claim 15 Schuster et al. discloses the messaging application of Claim 9 further comprising a connection to a telephony connection server (Fig. 2, ref. signs 250, 238 and 237) comprising a telephone account for the first telephone, the connection operable to communicate a connection status to the messaging application.

Referring to Claim 16 Schuster et al. discloses a method for communicating messages over a data network comprising the steps of:

detecting a voice over data communications channel between a first telephone and a second telephone (SIP Invite 506, Fig. 9B and respective portions of the spec.);

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detecting a voice over data communications channel to a third telephone (SIP Invite 508, Fig. 9B and respective portions of the spec.);

sending a messaging input screen (Figures 11 and 12) to the first telephone, the messaging input screen comprising a contact to the third telephone (ref. sign 512, Fig. 9B and respective portions of the spec.);

sending a connection data message to the third telephone to report the availability of the first telephone for messaging (ref. sign 516, Fig. 9B and respective portions of the spec.);

receiving a data message from the third telephone to the messaging application (ref. sign 522, Fig. 9B and respective portions of the spec.); and

sending the data message to the first telephone (ref. sign 518, Fig. 9B and respective portions of the spec.).

Referring to Claim 18, a method of communicating messages over a data network comprising the steps of:

detecting a voice over data communications channel between a first telephone and a second telephone (SIP Invite 506, Fig. 9B and respective portions of the spec.);

detecting a voice over data communications channel to a third telephone (SIP Invite 508, Fig. 9B and respective portions of the spec.);

sending a messaging input screen (Figures 11 and 12) to the first telephone, the messaging input screen comprising a contact to the third telephone (ref. sign 512, Fig. 9B and respective portions of the spec.);

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sending a connection data message to the third telephone (ref. sign 516, Fig. 9B and respective portions of the spec.);

receiving a data message at the messaging input screen (Figures 11 and 12 and respective portions of the spec.);

selecting the third telephone to receive the data message (ref. sign 520, Fig. 9B);

communicating the data message to the messaging application (ref. sign 504, Fig. 9B); and

communicating the data message to the third telephone (ref. sign 528, Fig. 9B and respective portions of the spec.).

Allowable Subject Matter

3. Claims 12, 13, 17 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

4. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-3988, (for formal communications intended for entry)

Or:

(703) 305-3988 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA. 22202, Sixth Floor (Receptionist).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamal A. Fox whose telephone number is (703) 305-5741. The examiner can normally be reached on Monday-Friday 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (703) 305-4366. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9315 for After Final communications.

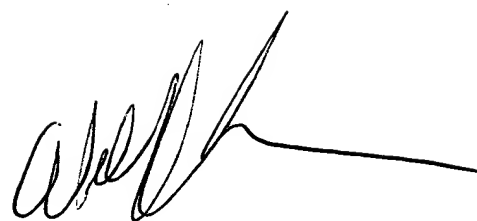
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

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J.A.F.
Jamal A. Fox

A handwritten signature in black ink, appearing to read 'W. Chin', with a long horizontal line extending to the right.

WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600